

### **REMARKS/ARGUMENTS**

Claims 124, 129-131 and 135-145 are pending and stand rejected in this application. The rejections to the presently pending claims are respectfully traversed.

#### **Claim Rejections – 35 U.S.C. §101 and §112, First Paragraph**

Claims 124, 129-131 and 135-145 are rejected under 35 U.S.C. §101 since allegedly "none of the asserted utilities are specific to the claimed nucleic acids, since such can be applied to any nucleic acid."

Claims 124, 129-131 and 135-145 were further rejected under 35 U.S.C. §112, first paragraph, allegedly "since the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility, one skilled in the art would not know how to use the claimed invention".

Applicants have asserted that U.S. Provisional Patent Application Serial No. 60/141,037, filed 23 June, 1999, discloses the gene amplification assay (shown in Example 170 of the instant specification) and establishes patentable utility for the claimed PRO1097 nucleic acids.

Applicants maintain, for the reasons set forth in the previously filed Appeal Brief, that the specification discloses at least one credible, substantial and specific asserted utility for the claimed PRO1097 nucleic acids. Applicants' arguments presented in the previously filed Appeal Brief are incorporated herewith in their entirety. As discussed before, the specification discloses that the gene encoding PRO1097 showed amplification, ranging from 2.313 to 2.346 fold in two different lung primary tumors and 2.114 to 2.532 fold in three different colon primary tumors under Example 170, which is sufficient disclosure for patentable utility for the PRO1097 nucleic acids.

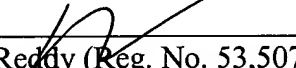
Thus, Applicants believe that these rejections under 35 U.S.C. §101 and §112, first paragraph, utility rejections should be withdrawn.

The present application is believed to be in *prima facie* condition for allowance, and an early action to that effect is respectfully solicited.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 08-1641, referencing Attorney's Docket No. 39780-2730 P1C62 and direct any calls in connection with this application to the undersigned at the number provided below.

Respectfully submitted,

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By:   
Daphne Reddy (Reg. No. 53,507)

(Panpan Geo  
43,626)

on behalf of Daphne  
Reddy

**HELLER EHRMAN LLP**  
275 Middlefield Road  
Menlo Park, California 94025  
Telephone: (650) 324-7000  
Facsimile: (650) 324-0638

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